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1 UNITED STATES PATENT AND TRADEMARK OFFICE
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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
6

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8 *Ex parte* HOWARD G. PAGE,
9 MIKE O'BRIEN,
10 and JAY CEE STRALEY
11

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13 Appeal 2011-008572
14 Application 09/498,515
15 Technology Center 3600
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18
19 Before LINDA E. HORNER, ANTON W. FETTING, and
20 MEREDITH C. PETRAVICK, *Administrative Patent Judges*.
21 FETTING, *Administrative Patent Judge*.

22 DECISION ON APPEAL
23

STATEMENT OF THE CASE¹

Howard G. Page, Mike O'Brien, and Jay Cee Straley (Appellants) seek review under 35 U.S.C. § 134 (2002) of a final rejection of claims 1, 5, 7, 8, 10-12, 17, 18, 20, and 21, the only claims pending in the application on appeal.² We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

The Appellants invented a video advertising system that selects and inserts video advertising into the video content of a video-on-demand system. (Specification 2:14-16). The invention selects video advertising for individual target viewers based on their viewer profile and their video content selection (Specification 3:13-15). The video advertising insertion system (1) receives a video stream carrying selected video content from a video-on-demand system, (2) selects and inserts video advertising into the video stream, and (3) transfers the video stream carrying both the selected video content and the selected video advertising for display to a target viewer. (Specification 3:18-23).

An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below [bracketed matter and some paragraphing added].

¹ Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed December 13, 2010) and Reply Brief ("Reply Br.," filed April 28, 2011), and the Examiner's Answer ("Ans.," mailed February 28, 2011).

² The Board issued a prior decision in the present application in Appeal 2007-1333 on November 6, 2007.

1 1. A method
2 for providing video advertising
3 where a video-on-demand system receives a request from
4 a target viewer for selected video content,
5 and in response,
6 transfers the selected video content in a video
7 stream to the target viewer,
8 the method comprising:
9 [1] selecting video advertising
10 that has a subject matter relation
11 to the selected video content
12 requested by the target viewer;
13 [2] determining an insertion point
14 in the selected video content
15 for the selected video advertising,
16 wherein the insertion point comprises
17 data indicating where
18 in the selected video content
19 the selected video advertising is to be
20 inserted;
21 [3] transferring the selected video content
22 to a target viewer device
23 over a first transport system
24 and
25 transferring the selected video advertising
26 to the target viewer device
27 over a second transport system,
28 wherein the first transport system uses greater
29 bandwidth for video transfer

1 than the second transport system;
2 [4] transferring the insertion point
3 to the target viewer device
4 over the second transport system;
5 [5] storing the selected video advertising
6 in video storage
7 of the target viewer device;
8 [6] transferring the selected video content
9 in the video stream
10 from the target viewer device
11 to a display device;
12 [7] interrupting the transferring
13 of the selected video content
14 in the video stream
15 at the insertion point;
16 [8] retrieving the selected video advertising
17 from the video storage;
18 [9] inserting the selected video advertising
19 into the video stream;
20 [10] resuming the transferring of the selected video content
21 in the video stream
22 at the insertion point;
23 and
24 [11] disabling fast-forward capability
25 when the selected video advertising is displayed.

1 The Examiner relies upon the following prior art:

Farmer	US 5,822,018	Oct. 13, 1998
Eyer	US 6,588,015 B1	Jul. 1, 2003
Zigmond	US 6,698,020 B1	Feb. 24, 2004
Swix	US 6,718,551 B1	Apr. 6, 2004

2 "NDS: NDS' XTV(TM) time shifting technology empowers th[e] viewer
3 and the broadcaster", M2 Presswire, Sep. 10, 1999.

4 Claims 1, 5, 7, 8, 10-12, 17, 18, 20, and 21 stand rejected under
5 35 U.S.C. § 103(a) as unpatentable over Swix, Farmer, Zigmond, XTV, and
6 Eyer.

7 ISSUES

8 The issues of obviousness turn primarily on whether the Examiner
9 presented articulated reasoning with rational underpinnings to transfer
10 Swix's video content and insertion data over separate transport systems as
11 required by limitations [2]-[4].

12 FACTS PERTINENT TO THE ISSUES

13 The following enumerated Findings of Fact (FF) are believed to be
14 supported by a preponderance of the evidence.

15 *Facts Found in the Prior Decision.*

16 01. The factual findings in the "FINDING OF FACT" section of
17 the prior Board decision mailed November 6, 2007 are adopted

and incorporated by reference.³

Farmer

01. Farmer is directed to normalizing signal levels in a signal processing system. (Farmer, col. 1, ll. 8-10.)

02. In many prior art CTV systems, ad-insertion is handled by a combination of cue tone detectors, switching equipment and tape players which hold the advertising material. Upon receipt of the cue tones, a CTV insertion controller automatically turns on a tape player containing the advertisement. Switching equipment then switches the system output from the video and audio signals received from the programming source to the output of the tape player. When switched, these successive program and advertising segments usually feed to a radio-frequency (RF) modulator for delivery to the subscribers. (Farmer, col. 1, ll. 37-51.)

03. In addition to the video and audio channels, Farmer's receiver 21 transmits cue tones on line 23 to ad-insertion system 24 which uses the cue tones to generate timing signals for controlling the insertion of advertising into the program material. When operated, switch 25 routes either the program audio and video, which appear on lines 22, or the advertising video and audio, which appear on lines 27, to modulator 30 via lines 33. Modulator 30 modulates the video and audio onto an RF carrier that it transmits to subscribers

³ The prior Board decision made findings of fact pertaining to claim construction of "transport" and "transport system" and the scope and content of Swix, Eyer, and XTV.

1 along with all other channels via combiner 28. (Farmer, col. 4, ll.
2 25-48.)

3 *Zigmond*

4 04. Zigmond is directed to displaying advertisements to viewers of
5 video programming by selecting and inserting advertisements into
6 a video programming feed at the household level. (Zigmond, col.
7 1, ll. 8-12)

8 ANALYSIS

9 This is the second time this application has come before the Board. In
10 the prior appeal, the Board panel affirmed the rejection of the claims then
11 pending in the application as being unpatentable over Swix, Eyer, and XTV.
12 As we stated *supra*, the invention inserts ads into a video stream. The
13 primary reference applied, Swix, does this by inserting tones in the video
14 stream that mark where ads are to be inserted. The video stream, containing
15 tone markers, is transmitted separately from the ads, and the two are merged
16 after transmission. Limitation [2] as drafted at the time of the Board's prior
17 decision essentially recited this, and the panel affirmed the Examiner's
18 rejections.

19 Subsequent to the prior appeal, Appellants added limitations that: altered
20 the insertion in limitation [2] to a determination of an insertion point; added
21 the wherein clause to limitation [2]; changed the object of the limitation [3]
22 transfers from a target viewer to a target viewer device; and added
23 limitations [4] through [10]. As a result, the Examiner now applies two
24 additional references, *viz.* Farmer and Zigmond.

1 In particular, because limitation [2] now determines an insertion point
2 rather than simply inserting the advertisement, and recites that the insertion
3 point comprises data, and limitation [4] transfers the insertion point data
4 over the transport system not used for the video content, Swix no longer
5 describes the insertion as claimed. Swix embedded the insertion points in
6 the video content precluding their transmission separate from the video
7 content.

8 Farmer describes a satellite system feeding a cable TV system for
9 broadcasting video content. Farmer has facial similarity to the claim, in that
10 it transmits cue tones separate from the video content to the cable operator to
11 show where to insert ads. The similarity falters because Farmer does so
12 prior to transmission from the cable operator to viewer. The claim limitation
13 [3] requires transferring content and ads separately to the target viewer
14 device over the two transport systems.

15 By the time the video in Farmer is transmitted to the viewer, the merge
16 has already occurred, apparently different from limitation [3]. Farmer does
17 this for at least the reason that Farmer is manipulating analog signals,
18 requiring expensive special purpose equipment, contrasted with Swix and
19 the claimed subject matter using digital data signals. Viewers are unlikely to
20 invest in such equipment for the benefit of the advertisers.

21 The Examiner attempts to clear this hurdle by construing the word
22 “over” to not require complete coverage. Ans. 8. That is, so long as any of
23 the signal transports occur separately, each is transferred over those separate
24 transports on their way to the target viewer. While such a construction may
25 be creative, it lands the Examiner on a paradox, for limitation [4] still

requires that the insertion point data arrive at the viewer device. Farmer's insertion data disappears with the merge process. The Examiner attempts to clear this hurdle by going back to Swix, suggesting one of ordinary skill would postpone the merge until the data reached the viewer. Ans. 4-5.

This essentially is the crux of two of Appellants' arguments. The first argument is that

[o]nly a single transport system exists between Farmer CTV System 20 and the target viewer devices. Therefore, it is not possible for Farmer to teach *transferring the insertion point to the target viewer device over the second transport system* as asserted in the Final Office Action because Farmer does not have a second transport system which links CTV System 20 to the target viewer devices. The Farmer timing signals and video content are combined at Switch 25 and transmitted to the target viewer devices over **a single transport system**.

Appeal Br. 6-7. The second argument is that the

purported motivation for combining Farmer with Swix is "in order for a local program to control the insertion point of the local advertisements" (pg. 3, lines 7-8). However, this motivation would not lead to use of Farmer. In Farmer, the Ad-Insertion System and the switching and modulating functions which combine the advertising material with the program material are located in the centralized distribution equipment of the cable television system (figs. 1 and 3). The advertisements are inserted into the program material before it is transmitted to the cable distribution system (fig. 1). Therefore, **Farmer does not teach or suggest allowing "a local program to control the insertion point of the local advertisements"** as stated in the Final Office Action.

Appeal Br. 8. Thus, one way or another, Farmer does not describe limitation [4] and the Examiner's attempt to provide Swix as motivation to carry the insertion data to the viewer device fails because, while Swix does indeed

show deferring insertion until signal arrival at the viewer device, Swix embeds the insertion data in the video content.

The Examiner attempts to clear this hurdle by introducing Zigmond, which does indeed merge an ad into video content at the viewer device based on a trigger signal separate from the video content. But Zigmond obtains the trigger data from the video content at the viewer device to do so. Zigmond does not support the Examiner's theory of keeping the insertion data separate from the video content during transmission. To the extent the Examiner is relying on Farmer's transmission from the satellite to the cable operator for such separate transmission, again, this would not apply in the digital domain of Swix and Farmer. Thus, we agree with Appellants that the Examiner failed to articulate a reason with rational underpinning to transfer Swix's video content and insertion data over separate transport systems.

The only remaining independent claim, claim 12, has comparable limitations.

CONCLUSIONS OF LAW

The rejection of claims 1, 5, 7, 8, 10-12, 17, 18, 20, and 21 under 35 U.S.C. § 103(a) as unpatentable over Swix, Farmer, Zigmond, XTV, and Eyer is improper.

DECISION

The rejection of claims 1, 5, 7, 8, 10-12, 17, 18, 20, and 21 is reversed.

REVERSED

JRG